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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,011	09/11/2003	* Adrian James Preston	GB920010070US1	5928
48916	7590	12/22/2006		
Greg Goshorn, P.C. 9600 Escarpment suite 745-9 AUSTIN, TX 78749			EXAMINER SCHELL, JOSEPH O	
			ART UNIT	PAPER NUMBER
			2114	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/22/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/660,011	Applicant(s) PRESTON ET AL.	
	Examiner Joseph Schell	Art Unit 2114	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Claims 1-16 and 18-21 have been examined.

Claims 1-16 and 18-21 have been rejected.

Response to Arguments

1. Applicant's arguments filed October 17, 2006 have been fully considered but they are not persuasive. Specifically, Applicant argues that Gustavsson ('796) does not disclose the limitation "extracting at least one minimum set of test events." Applicant further explains that Gustavsson ('796) is directed to a system that saves entire sets of inputs and outputs while the claimed subject matter is directed to a system that saves some test inputs and does not save others, thus the extraction of a minimum set. The examiner respectfully disagrees.

Claim 1 states "extracting at least one minimum set of test events from said trace file." Gustavsson ('796) column 3 lines 49-51 teaches that recorded input and output data may be used later for verifying of the same or other units. In order to use the input and output test data, the extracted data must inherently contain "at least a minimum set". Even if Gustavsson ('796) saves and extracts superfluous data in addition to the claimed "minimum set," this larger-than-necessary dataset inherently contains the minimum set. This is inherent because the test data is usable for future tests. Thus it is functional data and contains "a minimum set." While Gustavsson ('796) additionally provides no indication that superfluous or redundant information is stored and extracted, the lack of additional data not required by the claim.

Applicant's argument is especially unpersuasive in view of the "at least" language immediately preceding the "minimum set" limitation. This language serves to trivialize the "minimum set" limitation by allowing for additional data beyond the minimum to be included with the "minimum" set.

Claim Rejections - 35 USC § 101

Claims 18-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed toward a computer programming product. Computer program claims need to be tangibly, materially embodied to be considered statutory. While the claims state that the program is for recording events, the program product itself is claimed and the broadest reasonable interpretation of a program product includes nonstatutory embodiments such as abstract code and code in transmission.

This rejection is being given because while claim 18 cites the use of a computer storage, it is unclear from the preamble of the claim whether the storage is part of the system (line 2 of claim 18) or part of the computer programming product. Computer programming products do not generally comprise storage. If the computer storage (line 3 of claim 18) is meant to be part of the "computer programming product" then changing the end of line 2 of claim 18 to read "for use in a system, said computer programming product comprising" would obviate this rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 8-14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Gustavsson (US Patent 6,804,796).
3. As per claim 1, Gustavsson ('796) discloses a system for recording for reuse, at least one test event and at least one associated response, said system comprising:
 - an application program for testing at least one function of a component to be tested (column 3 lines 26-32);
 - a communication protocol for sending by said application program (column 3 lines 56-62), said at least one test event to said component and receiving from said component, said at least one associated response (column 2 lines 26-3);
 - storage for storing by a tracer, said at least one test event and said at least one associated response, in a trace file (column 3 lines 40-42);
 - an analyser for analysing said trace file (column 3 lines 45-46, the verification);and

an extractor for extracting at least one minimum set of test events from said trace file, wherein said at least one minimum set generates said at least one associated response (column 3 lines 49-52, and column 3 lines 41-45 the input and output data is recorded for use in later verifications); and said storage being further adapted to store said at least one minimum set and said at least one associated response (column 7 lines 47-54).

4. As per claim 2, Gustavsson ('796) discloses a system as claimed in claim 1, in which said analyser comprises means for determining whether said trace file is empty (column 5 lines 63-67, if a trace file is empty no pre-recorded input and output data will be retrieved, which would effectively stop the system in its tracks as everything depends on using that expected data).

5. As per claim 3, Gustavsson ('796) discloses a system as claimed in claim 1, in which said analyser comprises means for parsing said at least one test event (column 10 lines 5-12).

6. As per claim 4, Gustavsson ('796) discloses a system as claimed in claim 1, in which said analyser comprises means for creating at least one reusable program comprising said at least one minimum set and said at least one associated response (column 3 lines 49-55, the new output data is saved for subsequent system verifications).

7. As per claim 5, Gustavsson ('796) discloses a system as claimed in claim 4, in which said analyser comprises means for adding said at least one reusable program to said storage (column 3 lines 49-55).

8. As per claim 6, Gustavsson ('796) discloses a system as claimed in claim 1, in which two or more reusable programs share said at least one test event (column 11 lines 3-6, test events are sets of program input, and a shared test event would be a shared input; because a program is a set of input and pre-recorded output, the ability of a user to manually determine whether test results are acceptable implies that multiple acceptable outputs (both expected and unexpected) exist. These multiple outputs are multiple programs that share a common input event).

9. As per claim 8, Gustavsson ('796) discloses a system as claimed in claim 1, in which said component to be tested is at least one of a hardware component or a software component (see beginning of abstract, the system verifies a software-based unit).

10. As per claims 9-14 and 16, these are method versions of respective system claims 1-6 and 8 and are respectively rejected on the same grounds as claims 1-6 and 8.

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11. As per claims 18-21, these are computer programming product versions of claims 1-4 and are respectively rejected on the same grounds as claims 1-4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustavsson ('796).

13. As per claim 7, Gustavsson ('796) discloses the system as claimed in claim 6.

Gustavsson ('796) discloses the system wherein a user can manually decide whether a given output is acceptable (column 11 lines 3-6).

Gustavsson ('796) does not expressly disclose the system in which if said shared at least one test event generates two or more associated responses, said system further comprises means for invoking a rule for logging one of said two or more reusable programs.

At the time of invention it would have been obvious to a person of ordinary skill in the art to modify the system disclosed by Gustavsson ('796) such that outputs that are determined by a user to be acceptable are then saved with their associated inputs. This modification would have been obvious because waiting for user IO is a source of system slow-down (see column 1 lines 51-58), which would make the automatic mode execute faster than semi-automatic mode (as described in column 10 line 63 through column 11 line 6). Additionally, reproduced data sets are saved for future tests (column 1 line 67 through column 2 line 3). Saving the user-validated outputs would allow for the future use of these tests to be done automatically, saving personnel time.

14. As per claim 15, this is a method version of claim 7 and is rejected on the same grounds as claim 7.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Schell whose telephone number is (571) 272-8186. The examiner can normally be reached on Monday through Friday 9AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Baderman can be reached on (571) 272-3644. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS


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SUPERVISORY PATENT EXAMINER